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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,503	01/17/2002	Calvin Chunliang Lee		1608

7590 03/23/2004
Calvin Chunliang Lee
24294 Lynwood Dr.
Novi, MI 48374

EXAMINER

LEFLORE, LAUREL E

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,503

Applicant(s)

LEE, CALVIN CHUNLIANG

Examiner

Laurel E LeFlore

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inou 6,078,274 in view of Raj et al. 6,326,723 B1.

In regard to claims 1-16, see previous 103 rejections of claims 1-16 in paper number 5.

3. Further in regard to claim 1, Inou discloses pairs of the transparent electrode that face each other from different ones of the substrates being capable of selective contact with and separation from each other. See figure 1 and column 4, lines 20-32, disclosing "an insulating substrate 1 made of glass..., on which is provided a transparent conductive film 2a..., and...a flexible insulating substrate 3..., on which is provided a transparent conductive film 2b". See rejection of claims 1, 8, 13 and 16, disclosing transparent conductive films 2a and 2b are a pair of electrodes. It is inherent that the transparent electrodes from substrates 1 and 3 are capable of selective contact with and separation from each other, as the upper substrate is a flexible substrate.
4. In regard to claim 8, Raj discloses projections having a pitch shorter than 100 nm. See previous 103 rejections of claims 1-16 in paper number 5. Note page 4

DETAILED ACTION

Claim Objections

1. Claims 5 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In regard to claims 5 and 11, see previous objection to claims 5 and 11 in Paper No. 5.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris 5,488,392.

In regard to claims 1-6 and 13, see previous rejection of claims 1-6 and 13 in Paper No. 5.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris 5,488,392 in view of Jackson 6,611,139 B1.

In regard to claims 7-12 and 14, see previous rejection of claims 7-12 and 14 in Paper No. 5.

Response to Arguments

6. Applicant's arguments, see Item #2 and pages 18-24 of Paper No. 6 , filed 5 February 2004, with respect to amended claims 1-14 have been fully considered and are persuasive. The objection to the claims because of informalities of Paper No. 5 has been withdrawn.
7. Applicant's arguments filed 5 February 2004 have been fully considered but they are not persuasive.
8. In regard to Item #3 and the objection to claim 5 under 37 CFR 1.75(c), claim 5 is objected to for failing to further limit the subject matter of claim 1. Applicant argues that claim 5 is different from claim 3. However, this does not make claim 5 different from claim 1. Claim 5 describes the movement or position sensing means, which sends a signal to determine the movement or position of a cursor. This is described in items (g) and (h) of claim 1.
9. In regard to Item #4 and the objection to claim 11 under 37 CFR 1.75(c), claim 11 is objected to for failing to further limit the subject matter of claim 7. Applicant argues that claim 11 is different from claim 9. However, this does not make claim 11 different from claim 1. Claim 11 describes the movement or position sensing

means, which sends a signal to determine the movement or position of a cursor.

This is described in items (g) and (h) of claim 7.

10. In regard to Item #6 and the 35 U.S.C. 102(b) rejection of claims 1 and 5, applicant argues that the references fail to show certain features of applicant's invention. It is noted that the features upon which applicant relies (i.e., an outer case assembly or a canopy, and an extensive carriage top cover) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
11. In regard to Items #7-10 and 14, the 35 U.S.C. 102(b) rejection of claims 2-6 and 13, and the 35 U.S.C. 103(a) rejection of claims 7-12 and 14, see previous paragraph.
12. In regard to Items #11 and 13 and further in regard to the 35 U.S.C. 103(a) rejection of claims 7-12 and 14, and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
13. In regard to Item #12, see previous 35 U.S.C. 103(a) rejection of claim 12.
14. In regard to Item #15, it is not necessary for applicant to explain the differences between his invention and the cited patents. Clark 5,086,296 and Frank et al.

5,353,952 are merely cited as additional prior art that is pertinent to applicant's disclosure.

Conclusion

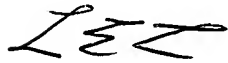
15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

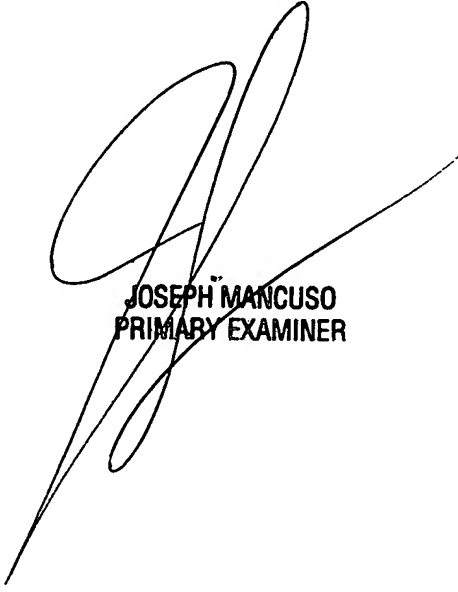
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel E LeFlore whose telephone number is (703) 305-8627. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on (703) 305-3885. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LEL
17 March 2004



JOSEPH MANCUSO
PRIMARY EXAMINER